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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/249,157	05/26/94	SUZUKI	M NAK1AN73

COULTER, EXAMINER

E3M1/0815

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ART UNIT	PAPER NUMBER
2315	10

DATE MAILED: 08/15/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 5/12/95 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ___ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474..
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☒ Claims 1-57 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-57 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☒ Other see attached

EXAMINER'S ACTION

Part III DETAILED ACTION

1. This action is in response to Applicant's Amendment A (paper # 8 mailed 5/12/95).

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

3. Claims 1 - 5, 13 - 19, 28 - 36, 44 - 46, 54, and 55 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3.1 The following claim language is vague and indefinite:

"customized" (claim 1, line 4; claim 13, line 4; claim 28, line 3; claim 54, line 6);

"a direction" (claim 3, line 7) as to the precise meaning of "direction";

"a user's direction" (claim 13, line 13) as to the precise meaning of "user's direction";

"both having" (claim 44, line 21; claim 47, line 23) as to the precise meaning of "both" (both registers or both of something else).

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5. Claims 1 - 5, 13 - 36, 44 - 57 are rejected under 35 U.S.C. § 103 as being unpatentable over Harmon in view of Sebesta and Killian et al. (U.S. Patent # 5,420,992).

5.1 Regarding claims 1 - 5, 13 - 36, 44 - 55, the rejection of claims 1 - 5, 13 - 36, 44 - 55 under 35 U.S.C. § 103 on 11/14/94 (paper # 5; paragraph 18) apply fully and are hereby incorporated by reference. In addition, Killian et al. (hereinafter referred to as Killian) teaches "N being designated by a user depending on the program size" (col. 3, lines 33 - 55). In addition, Killian discloses prohibition means for prohibiting a generation of a compensation instruction by the compensate instruction generating means when the option direction means is storing an indication denoting not to compensate (Fig. 4A; cols. 16, 17). Also, Killian discloses that the memory means has a storage capacity equivalent of up to 2 to the power N bytes (col. 3, lines 33 - 37). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Killian with Harmon because both references deal with allowing an M-bit data processors to manage N-bit addresses (N greater than M).

5.2 As per claims 56 and 57, the rejection of claims 1 and 13 respectively apply fully.

6. Regarding claims 6 - 12 and 37 - 43, the rejection of claims 6 - 12 and 37 - 43 under 35 U.S.C. § 103 on 11/14/94 (paper # 5; paragraphs 18 and 19) apply fully and are hereby incorporated by reference.

Response to Amendment

7. Applicant's arguments filed 5/12/95 have been fully considered but they are not deemed to be persuasive.

7.1 In response to Applicant's arguments under Section I (claims 1 - 12 and 56), the recitation that the program converter "converts any source program to any of a plurality of machine language programs for use by a corresponding plurality of microprocessors in a custom microprocessor series" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951). All of the argued material detailed above is in the preamble of claims 1 and 56.

7.2 In section II (claims 13 - 27, and 57), in response to Applicant's argument that Harmon does not recognize the problems

solved by the claimed invention, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

7.3 In section III (claims 28 - 36), the recitation involving an embedded custom microprocessor series comprising a plurality of microprocessors having different address bit widths is newly added language in the preamble of claim 28. Since this information is in the preamble it is not given any patentable weight (see paragraph 6.1 above for further explanation).

7.4 In section IV (claims 37 - 43), in response to Applicant's argument that neither Harmon nor Sebesta include certain features of Applicant's invention, the limitations on which the Applicant relies (i.e., "a protocol where the number of bits to be transmitted is designated according to an external indication") are not stated in the claims. Therefore, it is irrelevant whether the reference includes those features or not.

7.5 In section V (for claims 44 - 50), in response to Applicant's argument that neither Harmon nor Sebesta include

certain features of Applicant's invention, the limitations on which the Applicant relies (i.e., specifics involving whether to have zero extension and code extension based upon the type of register in which the immediate data is to be stored) are not stated in the claims. Therefore, it is irrelevant whether the reference includes those features or not.

7.6 In section VI (for claims 51 - 55), in response to Applicant's argument that neither Harmon nor Sebesta include certain features of Applicant's invention, the limitations on which the Applicant relies (i.e., a plurality of groups of flags) are not explicitly stated in the claims. Therefore, it is irrelevant whether the reference includes those features or not. In claim 54, the claim reads "selecting a certain flag group from said plurality of flag storing means".

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Killian et al. (U.S. Patent # 5,420,992) Backward-Compatible Computer Architecture With Extended Word Size and Address Space

Gotou et al. (U.S. Patent # 4,679,140) Data Processor with Control of the Significant Bit Lengths of General Purpose Registers

Kaplinsky (U.S. Patent # 4,361,868) Device for Increasing the Length of a Logic Computer Address

Gaither et al. (U.S. Patent # 4,453,212) Extended Address Generating Apparatus and Method

9. No claims are allowed.

10. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is (703) 305-8447. The examiner

can normally be reached on Monday through Friday from 7:00 AM to 4:30 PM.

The fax phone number for this Group is (703) 308-5356.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

krc
August 7, 1995